



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/381,480 12/10/99 CHEE

M 018547-03053

020350 HM12/0323
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER

CHAKRABARTI, A
ART UNIT PAPER NUMBER

1655
DATE MAILED:

03/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/381,480Applicant(s)
CheeExaminer
Arun ChakrabartiGroup Art Unit
1655**THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 12, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
 - ☐ will not be entered because:
 - ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-15

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

Art Unit: 1655

DETAILED ACTION

Applicant's request for reconsideration filed on March 12, 2001, have been considered but the applicant's arguments are not persuasive because of the following reasons.


Applicant argues that Cook reference does not teach steps of estimating or reestimating a target sequence (steps (d) and (g) in present claim 1). This argument is not persuasive because Cook reference clearly teaches steps of estimating or reestimating a target sequence (Example 28 and Table 3).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also argues that there is no motivation to combine the references. This argument is not persuasive, especially in the presence of strong motivation of Cronin et al as Cronin reference states, "The invention provides several strategies employing immobilized arrays of probes for comparing a reference sequence of known sequence with a target sequence showing substantial similarity with the reference sequence, but differing in the presence of, e.g., mutations" (Column 2, lines 8-12). By using this strong motivation and scientific reasoning, one ordinary artisan skilled in the art would have combined and substituted the method of comparing a reference sequence of known sequence with a target sequence showing substantial similarity with the reference sequence of Cronin with Cook reference in order to detect mutations.

Art Unit:

Moreover, Horwitz reference further provides express motivation as Horwitz states, "Because of the recent identification of several classes of human endogenous retroviruses and our interest in obtaining a better understanding of the evolution of human immunodeficiency virus (HIV), experiments were performed to detect the presence of HIV-1 related sequences in normal human DNA." (Page 2170, column 2, second paragraph, lines 1-6).


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

3/23/01